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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/820,496	03/19/1997	WILLIAM GEORGE WILHELM		2970

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ALFRED M. WALKER
225 OLD COUNTRY ROAD
MELVILLE, NY 11747-2712

EXAMINER

FLEMING, FRITZ M

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 01/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/820,496

Applicant(s)

WILHELM, WILLIAM GEORGE

Examiner

Fritz M. Fleming

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-54, 56 and 117 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-54 and 56-117 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 116 has been renumbered 117. ***Claim Rejections - 35 USC***

§ 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 117 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 117 has an antecedent basis problem, in that there is no clear antecedent basis for "said power control means." Thus the claim is vague and indefinite.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 117 is rejected under 35 U.S.C. 102(b) as being anticipated by ERTZ III.

In ERTZ III please note the following:

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The lamps 16 are high pressure sodium discharge, or metal halide, which are highly efficient to the extent claimed.

The point of ERTZ III is to operate in normal and emergency modes. In the normal mode, the energy supplied to the lamps 16 is provided by the AC input from the utility. A battery charger is seen at 28 with the intent to keep the batteries charged during normal mode operations. During an emergency mode of operation when the AC fails, the battery 24 forward biases the diode 26 so as to provide the required DC for the lights so the lights will operate in the same manner as the normal mode. Continued operation is ensured even in the case of an AC fail. The converter 18 changes the AC to DC, as well as supplying the DC to the battery charger. The power controller is seen as 12 and in emergency mode, it is clear that the only operational source is the batteries 24, hence the batteries supply all needed power to the lights and to the controller 12 to ensure proper operations during the emergency mode. The claimed connections are seen in Figure 2 as the utility grid input comes in to the converter 18 and the required DC leaves at 20 going to the ballasts 22.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 49-51, 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alenduff et al. in view of Yamanaka and Drinkwater and Morita.

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Alenduff et al. are concerned with the same concept of reducing peak usage charges.

See columns 1-3. The device uses a setpoint value to determine when the supplemental source is to be brought into parallel operation. Also note the primary AC source 14, the alternative primary source of AC at 24, a load 18, a power controller 34/36/30/20/32 which allows power from 24 to be added to power from 14 when needed. Memory means need a backup per column 6, lines 9-19, thus requiring that a secondary source of DC (a backup battery) be present. The power junction means are seen at 16 and 34, in which the junction is biased to provide the required AC from 14/24 to the load 18. What is lacking is the DC nature of the supply to the load 18. Note that column 8 suggests the use of an existing emergency standby generator to serve as 24, thus setting forth motivation to use emergency backup supplies in place of 24.

Yamanaka is just such an emergency back up that uses a primary source of AC at 101 that is rectified to DC at 11 with the backup supplied by 12 and both feeding the DC to DC converter 13 which supplies a DC stabilized (i.e. the claimed defined DC regulated) Voltage to the load 102. The battery 12 provides emergency supply during an AC fail to power the load at 102. Thus this is a backup as required by Alenduff.

Drinkwater teaches a similar battery backup at 14, with the AC converted per Figure 2, with the battery and capacitor 14/15 providing ride through and backup. Thus this is a backup as required by Alenduff.

Finally, Morita shows a battery backup of the type required for Alenduff's 40. The memory 4a as well as memory 6 are supplied by the rechargeable battery Vb.

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Thus it would have been obvious to one having ordinary skill in the art at the time that the invention was made to modify Alenduff per the teachings of Yamanaka and Drinkwater and Morita when it is desired to operate the principles of Alenduff's peak shaving in a DC load environment. This involves the elementary application of routine skill in the art to modify the AC source/load system of Alenduff to have a primary source of AC (as set forth by Alenduff and Drinkwater and Yamanaka) with an alternate primary source of DC (i.e. to replace the 24 of Alenduff with a battery based backup of Drinkwater and Yamanaka) when the load to be supplied is that of a DC type such as those of Yamanaka and Drinkwater. Morita adds a rechargeable battery to back the memory of Alenduff 40 as the requirement exists in Alenduff to have the memory 40 be battery backed up. Thus the combined teachings set forth the peak shaving to be carried out by a DC type emergency back up, as Alenduff requires that the peak shaving source be an emergency back up. By merely modifying the type of backup to be of the DC variety when the loads require DC is a mere matter of common sense and routine skill in the art. The secondary references combined with Alenduff do just that. As far as claim 56 is concerned, it would make sense to combine all available battery power in an AC fail mode to drive the load as long as possible. Thus to combine the backup of Morita with the backup of Drinkwater and Yamanaka makes sense, especially when the load is a computer related device. However, the teachings are applicable to any DC load, even the claimed lighting.

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8. Claims 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alenduff et al. in view of Yamanaka and Drinkwater and Morita as applied to claims 49-51,56 above, and further in view of Keefe et al.

Alenduff et al. in view of Yamanaka and Drinkwater and Morita lack the specific DC sources.

Keefe et al. set forth that it is old and well known in the art to use potentially less expensive sources such as wind, sunlight and geothermal sources to supply energy needs. Note that Y may be a utility, thus suggestive of a combined AC DC system for supplying the load L. Motivation to combine is found at the top of column 9 which states that the power is supplied to the load L by both 10 and Y.

Thus it would have been obvious to one having ordinary skill in the art at the time that the invention was made to modify Alenduff et al. in view of Yamanaka and Drinkwater and Morita per the teachings of Keefe et al. when it is advantageous to benefit from the use of potentially less expensive sources such as wind, sunlight and geothermal sources to supply energy needs. Thus the claimed sources are rendered obvious.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Applicant's arguments with respect to claims 49-54,56,117 have been considered but are moot in view of the new ground(s) of rejection.

As indicated in the interview, the amended material defined over the rejection of record. However, the amendments resulted in new claims and claim limitations not previously searched. Hence the application of new art is proper in this FINAL REJECTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fritz M. Fleming whose telephone number is 703-308-1483. The examiner can normally be reached on M-F 0630-1500.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 703-308-3301. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

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A handwritten signature in black ink, appearing to read 'Fritz M. Fleming', with a stylized flourish at the end.

Fritz M. Fleming
Primary Patent Examiner
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fmf

January 15, 2003